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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/730,219	12/05/2000	Ghassan Chidiac	YOR920000746US1	9167

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McIntyre Harbin & King  
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EXAMINER

ALAM, SHAHID AL

ART UNIT PAPER NUMBER

2162

DATE MAILED: 04/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/730,219

Applicant(s)

CHIDIAC ET AL.

Examiner

Shahid Al Alam

Art Unit

2162

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed on January 23, 2006 have been fully considered but they are not persuasive.
2. Applicant argues that the examiner contends applicants inherently admits that determining or selecting an optimal one of plural file formats from which to begin a translation constitutes admitted prior art and the examiner clearly misconstrues applicant's disclosure.

Examiner respectfully disagrees the allegations as argued. Examiner, in his previous office action, gave detail explanation of claimed limitation and pointed out exact locations in the cited prior art.

Examiner is entitled to give claim limitations their broadest reasonable interpretation in light of the specification.

#### **Interpretation of Claims-Broadest Reasonable Interpretation**

During patent examination, the pending claims must be 'given the broadest reasonable interpretation consistent with the specification.' Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 162 USPQ 541,550-51 (CCPA 1969).

In response to applicant's admitted prior art or background of the invention, the background of the invention ordinarily comprises two parts: (1) Field of the Invention: A statement of the field of art to which the invention pertains.

Art Unit: 2162

This statement may include a paraphrasing of the applicable U.S. patent classification definitions. The statement should be directed to the subject matter of the claimed invention. (2) Description of the related art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98: A paragraph(s) describing to the extent practical the state of the prior art or other information disclosed known to the applicant, including references to specific prior art or other information where appropriate. Where applicable, the problems involved in the prior art or other information disclosed which are solved by the applicant's invention should be indicated. See also MPEP § 608.01(a), § 608.01(p) and § 707.05(b).

For the above reasons, Examiner believed that rejection of the last Office action was proper.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 – 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 5,608,874 issued to Stuart Ogawa et al. ("Ogawa") and in view of Applicants' Admitted Prior Art ("APA").

With respect to claim 1, Ogawa teaches a method for selecting a file format from a plurality of stored file formats for use in performing a translation from said selected file format to a requested file format (see Abstract), the method comprising the steps of:

receiving a request for a data file in a requested format (column 34, lines 17 – 19);

determining a file format from a plurality of stored files for use in performing said translation to said requested file format (column 2, lines 30 – 36 and lines 54 – 61); and

translating the file format of said data file determined in said determining step to the requested file format (column 2, lines 54 – 61 and column 34, lines 60 – 64) and

providing the requested file format to a user (examiner interprets as displaying to user; see also column 6, lines 46 – 48 and column 23, lines 14 – 18).

Ogawa does not explicitly teach an optimal file format from a plurality of stored file formats as claimed.

APA discloses claimed optimal file format from a plurality of file format. APA discloses a requested data file exists within an enterprise in many different formats other than the requested format, . . . for selecting the optimal version of a requested data file from which to perform the translation (see APA, 2<sup>nd</sup> Paragraph of page 3).

It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to combine APA with Ogawa to automatically understand what specific format translations are needed for a specific data recipient, then to be able to automatically carry out such a translation regardless of what format the data was originally in. It would be desirable for a system to operate with minimal user interaction,

Art Unit: 2162

making it faster, cheaper, and more reliable than manual or semiautomatic performance of such tasks (column 2, lines 30 – 43; Ogawa).

As to claims 2 and 3, Ogawa teaches all of the limitation as claimed except Ogawa does not explicitly teach minimizing data loss and minimizing file size as claimed.

APA teaches claimed minimization and optimization by selecting the optimal version of a requested data file from which to perform the translation (see APA, 2<sup>nd</sup> Paragraph of page 3).

It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to combine APA with Ogawa to automatically understand what specific format translations are needed for a specific data recipient, then to be able to automatically carry out such a translation regardless of what format the data was originally in. It would be desirable for a system to operate with minimal user interaction, making it faster, cheaper, and more reliable than manual or semiautomatic performance of such tasks (column 2, lines 30 – 43; Ogawa).

As to claim 4, determining step is based upon the requested file format and available stored file formats (column 34, lines 17 – 50).

As to claim 5, wherein said determining step further includes the step of consulting an optimized list of file formats from which to perform said translation of said stored data file to the requested file format (Ogawa: column 16, lines 18 – 23; Note that the “Subscriber Translation Information” of Ogawa reads on an optimized list of file formats).

As to claim 6, said list is indexed by said requested file format (column 34, lines 50 – 64).

As to claim 7, said optimized list is consulted if the data file is stored in a plurality of formats (Ogawa: column 16, lines 18 – 23; Note that the “Subscriber Translation Information” of Ogawa reads on an optimized list of file formats and see also APA, 2<sup>nd</sup> Paragraph of page 3).

As to claim 8, said consulting step further includes selecting one of said optimized list from a plurality of said optimized lists (Ogawa: column 16, lines 18 – 23; Note that the “Subscriber Translation Information” of Ogawa reads on an optimized list of file formats and see also APA, 2<sup>nd</sup> Paragraph of page 3).

As to claim 9, ordering of said optimized lists is based on criterion regarding the translation to be performed on the stored data file (column 2, line 59 – column 3, line 4).

As to claim 10, said criterion is defined by a received request for said data file (column 2, line 59 – column 3, line 4).

As to claim 11, accessing a portion of said optimized list ordered based upon the requested file format; determining whether one or more of said listed file formats exists as one of said stored file formats; and selecting from said optimized list the optimal file format that is determined to exist as a stored file format (a requested data file exists within an enterprise in many different formats other than the requested format, . . . for selecting the optimal version of a requested data file from which to perform the translation (see APA, 2<sup>nd</sup> Paragraph of page 3 and also Ogawa: column 16, lines 18 –

Art Unit: 2162

23; Note that the "Subscriber Translation Information" of Ogawa reads on an optimized list of file formats).

The subject matter of claims 12 – 23 are rejected in the analysis above in claims 1 – 11 and these claims are rejected on that basis.

### ***Conclusion***

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.



***Contact Information***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shahid Al Alam whose telephone number is (571) 272-4030. The examiner can normally be reached on Monday-Thursday 8:00 A. - 4:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Shahid Al Alam  
Primary Examiner  
Art Unit 2162

3 April 2006